UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,398	11/19/2003	Robert A. Loc	58594US002	7478

32692 7590 10/01/2007	EXAMINER
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427	NELSON, FREDA ANN

ART UNIT	PAPER NUMBER
3628	

NOTIFICATION DATE	DELIVERY MODE
10/01/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com
LegalDocketing@mmm.com

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/717,398	LOE ET AL.
	Examiner	**Art Unit**	
	Freda A. Nelson	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30-50</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-50</u> is/are pending in the application.

    4a) Of the above claim(s) <u>1-29</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>30-50</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

The amendment received on June 18, 2007 is acknowledged and entered. Claims 1-29

have been withdrawn. Claims 1-50 are currently pending.

Election/Restrictions

Claims 1-29 are withdrawn from further consideration pursuant to 37 CFR

1.142(b) as being drawn to a nonelected invention, there being no allowable generic or

linking claim. Election was made **without** traverse in the reply filed on June 18, 2007.

Claim Rejections - 35 USC § 101

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine,

manufacture, or composition of matter or any new and useful improvement

thereof, may obtain a patent therefore, subject to the conditions and

requirements of this title".

1.   Claims 30-50 are rejected under 35 U.S.C. § 101 because the claimed invention

is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new

and useful process, machine, manufacture, *or* composition of matter, *or* any new and

useful improvement thereof" (emphasis added). Applicant's claims mentioned above

are intended to embrace or overlap *two* different statutory classes of invention as set

forth in 35 USC 101. The claims begin by discussing a system (ex. preamble of claim

30), the body of the claim discusses the specifics of software module, and subsequently

the claim then deals with the steps executed by software module (see above rejection of

claims under 35 USC 112, second paragraph, for specific details regarding this issue).

"A claim of this type is precluded by the express language of 35 USC 101 which is

drafted so as to set forth the statutory classes of invention in the alternative only", Ex

parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out
> and distinctly claiming the subject matter which the applicant regards as his
> invention.

2.   Claims 30-50 are rejected under 35 U.S.C. § 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

In particular, claim 30 recites in the preamble "system comprising a value

modeler software module executing on a computing device", however, the body of the

claim does not contain any limitations indicating the structure of the device. A system or

an apparatus claim should always claim the structure or the hardware that performs the

function. Applicant's claimed limitations consist of modules (software according to the

specification) that do not describe the structure of the device. Appropriate correction is

required.

In regards to claim 30, the examiner is unable to determine the novel part of the

claim or the intended use.

In regards to claim 30, the claim language "calculates a metric of improvement if at least one information component associated the process were digitized" is indefinite. Applicant has not positively recited "calculating a metric of improvement when at least one...process were digitized".

Claim 36 recites the limitation "the total amount" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "the percentage" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "the percentage" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "the total time" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "the total resources" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 37 recites the limitation "the computed total costs" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 41 recites the limitations "the first information flow" and "the second information flow" computed total costs" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

In regards to claim 41, the claim language "compares the metric to determine if the information component were digitized" is indefinite. Applicant has not positively recited "comparing the metric to determine when ...were digitized.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   **Claims 30-31, 33, 40-41, 47-48 and 50 are rejected under 35 U.S.C. 102(e) as**

being Anticipated by Knight (US PG pub. 2004/0024622).

As per claims 30 and 47, Knight et al. discloses a system comprising a value

modeler software module executing on a computing device, wherein the value modeler

software module processes an information flow model that models the flow of

information through a process of an enterprise, and calculates a metric of improvement

for the process if at least one information component associated with the process were

digitized (paragraphs [0007],[0016]).

As per claims 31 and 48, Knight discloses the system of claim 30, wherein the

metric comprises one of quality, cycle time, productivity, cost, and revenue ([0037]).

As per claim 33, Knight disclose the system of claim 32, wherein the value

modeler presents a user interface for assigning costs to each of the tasks (see FIG. 1).

As per claims 40-41 and 50, Knight discloses the system of claim 30, wherein the information flow model comprises a first information flow model that models current operation of the process, and the value modeler calculates the metric by processing a second information flow model that models the flow of information through the process if the information component were digitized (paragraph [0007]); and wherein the value modeler calculates respective metrics associated with the first information flow model and the second information flow model, and compares the metrics to determine a potential benefit if the information component were digitized (paragraph [0016]).

4.   Claims 32 and 37-39 are rejected under 35 U.S.C. 102(e) as being Anticipated by Knight (US PG Pub. 2004/0024622), in view of Casati et al. (US PG Pub. 2003/0225644).

As per claim 32, knight et al. does not expressly disclose the system of claim 30, wherein the value modeler comprises a database that stores data defining the information flow model as a set of tasks associated with the process, wherein the data defines relationships based on dependencies between the tasks.

However, Casati et al. disclose many business-related processes depend upon the execution of pre-defined tasks. Computers and other automated systems are applied to automating a number of these pre-defined tasks, handling such aspects as: identification and allocation of resources; time management; inventory control; accounting procedures; etc. (paragraph [0002]); and the process data is generated by a process engine 124 configured to gather and store process instance data as process

execution progresses, wherein the process instance data within the store 112 can

include, for example: overall process definitions; specific sub-steps, or

`nodes` within a defined process; process instance input parameters; process

instance output parameters; process instance activation and completion time(s);

process instance priority; and input and output parameters, activation and

completion time(s) and priorities for each node within a process instance (paragraph

[0019]).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the invention of Knight to include the feature

Casati et al. in order to provide a database which stores the data for easy retrieval.

As per claim 37, Knight does not disclose the system of claim 30, wherein the

value modeler computes one or more total costs associated with the information flow

model, and generates a financial report that presents the computed total costs.

However, Casati et al. disclose the process instance data includes data

representing total cost of the process (see claims 10 and 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the invention of Knight to include the feature of

Casati et al. to provide the user with total cost of the process in order for the user to

make a determination whether to automate processes.

As per claims 38-39 and 49, Knight does not disclose the system of claim 30, wherein the value modeler computes at least one of total hard dollars, total soft dollars, and total dollars for each of a set of enterprise functions associated with the process; and wherein the value modeler computes at least one of total hard dollars, total soft dollars, and total dollars expended during the modeled process.

However, Casati et al. discloses However, Casati et al. disclose the process instance data includes data representing total cost of the process (see claims 10 and 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Knight to include the feature of Casati et al. to provide the user with total cost of the process in order for the user to make a determination whether to automate processes.

5.   **Claims 34-35 are rejected under 35 U.S.C. 102(e) as being Anticipated by Knight (US PG Pub. 2004/0024622), in view of Humenansky et al. (US Patent Number 7,072,822).**

As per claim 34, Knight et al. do not disclose the system of claim 30, wherein the data defines a set of enterprise functions involved in the process, and maps the tasks to the enterprise functions.

However, Humenansky et al. disclose generating a deployment map that associates each of a set of enterprise planning models with a respective set of application servers, wherein each of the enterprise planning models is associated with a

different enterprise planning session and defines a plurality of hierarchically arranged

nodes to represent an organization of an enterprise; processing jobs associated with

the enterprise planning models with the respective sets of application servers according

to the deployment map to perform one or more tasks associated with the enterprise

planning sessions; receiving input modifying one or more of the enterprise planning

models that defines a set of enterprise contributors, wherein each of the contributors is

associated with a different slice of the modified enterprise planning model; upon

accesses to an enterprise planning system by the contributors, communicating the input

and data associated with the respective slices of the modified enterprise planning

model to computing devices of the contributors; and processing the input to

update the slices of the modified enterprise planning model on the computing

devices of the contributors (see claim 1).

As per claims 35, Knight does not disclose the system of claim 30, further

comprising graphical design software that illustrates the flow of the information through

the process.

However, Humenansky et al. discloses the web pages may include static media,

such as text and graphic imagery, as well as conventional input media such as text

entry boxes, radio buttons, drop-down menus, and the like, for receiving information

from enterprise users 18.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the invention of Knight to include the feature of

Humenansky in order to provide the user with a visual of the process.

6.   **Claims 36 and 43-46 are rejected under 35 U.S.C. 102(e) as being**

Anticipated by Knight (US PG Pub. 2004/0024622), in view of Charisius et al. (US

PG Pub. 2002/0075293).

As per claim 36, Knight does not disclose the system of claim 30, wherein the

graphical design software presents a user interface that includes one or more of :

an input region to receive a description of the task; an input region to receive an

elapsed time that specifies the total amount of time that elapses from start to completion

of the task; an input region to receive a loop/branch weight that indicates the

percentage of time the task is actually performed; an input region to receive a total

resource time that indicates the total time expended by a resource during the task; ·

an input region to receive a resource quantity that indicates the total resources

allocated to the task; an input region to receive a type of resource allocated to the task;

an input region to receive a hard cost associated with the resource; an input region to

receive a percentage of material cost associated with the task; and an input region to

receive a percentage of material hard cost associated with the task.

However, Charisius et al. disclose, for example, FIG. 35 depicts a user interface 3500

displayed by the Client Interface to receive a role profile. In the implementation shown

in FIG. 35, the Client Interface receives a Rolename 3502 (e.g., "Project Manager") for

the role profile via the enterprise affiliate clicking on an "Add" button 3504 and then

entering Rolename 3502 in a dialog box 3506 that is displayed by the Client Interface.

In another implementation, the Client Interface may also receive as additional entries

(not shown) to dialog box 3506 a skill and an associated skill level for Rolename 3502

as part of this role profile (paragraph [0135]).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the invention of Knight to include the feature of

Charisius in order to provide the user with visuals.

As per claims 43-45, Knight does not disclose the system of claim 30, further

comprising a digitization repository to store the digitized information component with

other digitized information components; a computer to retrieve the digitized information

components from digitization repository, and dynamically generate display output from

the digitized information components; and wherein the digitization repository comprises:

a file server to store the digitized information components; and a database management

system to provide an index for retrieving the digitized component.

However, However, Charisius et al. disclose, for example, FIG. 35 depicts a user

interface 3500 displayed by the Client Interface to receive a role profile. In the

implementation shown in FIG. 35, the Client Interface receives a Rolename 3502 (e.g.,

"Project Manager") for the role profile via the enterprise affiliate clicking on an "Add"

button 3504 and then entering Rolename 3502 in a dialog box 3506 that is displayed by

the Client Interface. In another implementation, the Client Interface may also receive as

additional entries (not shown) to dialog box 3506 a skill and an associated skill level for

Rolename 3502 as part of this role profile (paragraph [0135]).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the invention of Knight to include the feature of

Charisius et al. in order to provide the user with storage for easy retrieval of digital

information.

As per claim 46, Knight does not disclose the system of claim 45, wherein the

database management system comprises one of a relational database management

system, a hierarchical database management system, a multidimensional database

management system, an object-oriented database management system, and an object-

relational database management system.

However, Charisius et al. disclose in one implementation, WebDAV storage 142

may be a known database, such as Oracle, DB2, MS Structured Query Language

(SQL) storage, or any Java Database Connectivity (JDBC)-compliant database. In this

implementation, WebDAV Server 140 includes a database management system

(DBMS) or a JDBC interface to control access to the WebDAV storage 142 (paragraph

[0084]).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the invention of Knight to include the feature of

Charisius et al. in order top provide the user with a system for managing the database

for easy retrieval.

7.   Claim 42 is rejected under 35 U.S.C. 102(e) as being Anticipated by Knight

(US PG Pub. 2004/0024622), in view of Ambler et al. (US PG. Pub. 2002/0111989).

As per claim 42, Knight does not disclose the system of claim 41, wherein the value modeler compares the metrics to determine a potential return on investment if the information component were digitized.

However, Ambler et al. disclose an underlining foundation of workflow software is that the computer code for such software has been designed with a set of rules and processes for the type of activity that a company finds itself in. These rules and procedures are selected, for instance, such that the company realizes a desirable degree of return on the company's investment. As such, the software can be proved for its worthiness to serve a business interest (paragraphs [0009],[0024]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Knight to include the feature of Ambler et al. in order to provide the user the ability to analyze the feasibility or automating processes.

Conclusion

1.   The examiner has cited prior art of interest, for example:

1) Buteau et al. (US Patent Number 6,442,557), which disclose an evaluation of enterprise architecture model including relational database.

2) El Ata (US PG Pub. 2002/0049573), which disclose an automated system and method for designing model based architectures of information systems.

3) Middleton (US PG Pub. 2005/0065841), which discloses a method for assessing information technology needs in a business.

4) Plumer et al. (US PG Pub. 2001/0049595), which disclose a system and method for enterprise modeling, optimization and control.

5) Sanders (US Patent Number 6,411,936), which discloses an enterprise value enhancement system and method.

6) Gray et al. (US PG Pub. 2004/0024662), which disclose an equipment documentation management system, method, and software tools.

7) LaComb et al. (US PG Pub. 2004/0138933), which disclose a development of a model for integration into a business intelligence system.
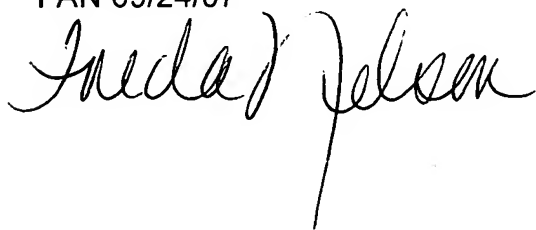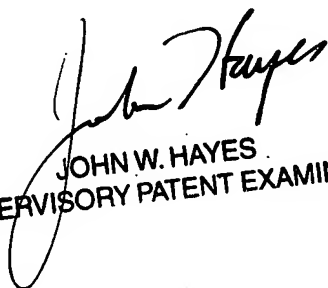

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday -Wednesday and Friday, 10:00 AM -6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FAN 09/24/07

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER